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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,061	05/01/2001	Guang Yang	P-092-R	4558

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EXAMINER

LIU, SAMUEL W

ART UNIT PAPER NUMBER

1653

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/847,061

Applicant(s)

YANG ET AL.

Examiner

Samuel W Liu

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-17 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_\_

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14, drawn to the glycopeptide, is classified in class 530, subclasses 395 and 402, class 514, subclass 8, class 424, subclass 278.1.
- II. Claims 15-17, drawn to a method of treating a mammal having bacterial disease, are classified in class 514, subclass 8, and class 424, subclass 278.1.

The inventions are distinct, each from the other because of the following reasons:

Invention I is related to Invention II as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the glycopeptide can be immobilized on the chip-gold surface using surface plasma resonance technique for detecting real time protein-protein interaction, for example.

***Additional Election Under 35 USC 121***

Irrespective of whichever group applicant may elect, applicant is further required under 35 US 121 to elect a single glycopeptide structure to which claims are restricted.

If any Group I is elected, applicant is required to elect Formula I or Formula II (under the proviso set forth in claim 1, the last three paragraphs) from claim 1.

If Formula I is elected, applicant is further required to elect one chemical group for R<sup>1</sup>, R<sup>2</sup>, R<sup>3</sup>, R<sup>4</sup>, R<sup>5</sup>, R<sup>6</sup>, R<sup>7</sup>, R<sup>8</sup>, R<sup>9</sup>, R<sup>10</sup>, R<sup>11</sup>, R<sup>12</sup>, R<sup>13</sup>, R<sup>14</sup>, X<sup>1</sup>, X<sup>2</sup> and X<sup>3</sup> from claim 1, Formula I, wherein one subgroup: R<sup>a</sup>, or/and R<sup>b</sup>, or/and R<sup>c</sup>, or/and R<sup>d</sup>, or /and R<sup>e</sup>, or/and R<sup>f</sup>, or/and Y, and

Art Unit: 1653

or/and Z should be defined and elected with the defined index number "n" or/and "x", if wherein the R<sup>a</sup>, or/and R<sup>b</sup>, or/and R<sup>c</sup>, or/and R<sup>d</sup>, or/and R<sup>e</sup>, or/and R<sup>f</sup>, Y or/and Z are applicable thereof. For group R<sup>1</sup> especially, applicants are required to elected (i) one structural moiety from claim 2 with the defined subgroup R<sup>a</sup>, or/and R<sup>b</sup>, or/and Z, or/and R<sup>f</sup>, or/and Y, or/and "x", or, (ii) the structural moiety (formula) set forth in claim 3 wherein R<sup>15</sup> should be elected from one sub-structural-moiety from claims 3 and 5 with the defined subgroup R<sup>a</sup>, or/and R<sup>b</sup>, or/and Z, or/and R<sup>f</sup>, or/and Y, or/and "x", or/and R<sup>16</sup>, or, (iii) one substituent group from claims 4 or, claim 6 in which one subgroup R<sup>17</sup> should be elected for R<sup>15</sup> (from claim 16 only).

If Formula II is elected, applicant is further required to elect (i) one chemical group for R<sup>20</sup> with the defined R<sup>a</sup>, or/and R<sup>b</sup>, or/and Y, or/and Z, or/and R<sup>f</sup>, or/and the defined index number "x" from claims 7 and 10, or (ii) one substituent group from claim 11 or claim 12. Please note that there is inconsistent claim number (claim 27) in claim 10; yet, examiner has assumed the recited "claim 27" is claim 7 instead of claim 2 because only claim 7 formula contains both R<sup>19</sup> and R<sup>20</sup> but of claim 2 and claim 1 from which claim 2 depends do not.


The above additional election is required because the glycopeptides defined by each chemical group and/or subgroup thereof are distinct/different in structural and functional properties. Note that the election stated forgoing is NOT a species election, but is an additional election under 35 U.S.C. 121 since each composition is patentably distinct.

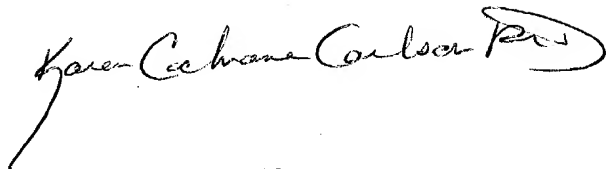
Because these inventions are distinct for the reasons given above and have acquired a separate status in the art shown by their different classification, art recognized divergent subject matter, separate search, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1653

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel Wei Liu, Ph.D. whose telephone number is 703-306-3483. The examiner can normally be reached Monday-Friday 9:00 -5:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Christopher Low can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communication and (703) 305-3014 for the after final communication. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

  
Samuel W. Liu, Ph.D.  
September 15, 2003

  
KAREN COCHRANE CARLSON, PH.D.  
PRIMARY EXAMINER